



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JJGJR.. 09-04

Paper No: _____

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY, AND POPEO, P.C.
One Financial Center
Boston MA 02111

COPY MAILED

SEP 16 2004

OFFICE OF PETITIONS

In re Application of
Jeffers, et al. :
Application No. 09/992,840 :
Filed: 6 November, 2001 :
Attorney Docket No. 15966-557A (Cura 57A) :

ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 22 June, 2004.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.
- (3) Petitioner may find that the scheduling of a Request for Status at six- (6) month intervals may prevent delays such as the one that occurred in this matter between 6 February, 2002, and 22 January, 2004. Moreover, the Office may require evidence of such request to demonstrate diligence consistent with the Pratt¹ requirements.

¹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

BACKGROUND

The record indicates:

- the application was filed on 6 November, 2001, without, *inter alia*, a fully executed oath or declaration;
- the Office mailed a Notice of Missing Parts (*inter alia*, oath/declaration) on 5 December, 2001 (the 5 December Notice), however, it appears that the 5 December Notice was not received by Petitioner, and ultimately the Office re-mailed the Notice on 22 January, 2002 (the 22 January Notice), with a response due absent extension of time on or before 22 March, 2004;
- on 22 June, 2004, Petitioner filed, *inter alia*, a request and fee for a three- (3-) month extension of time, an oath/declaration signed by the inventors (on behalf of themselves and) save for the non-responsive inventor Elma Fernandes (Ms. Fernandes), and the instant petition (statements by Ivor Elrifi (Reg. No. 39,529) and Kristin E. Konzak (Reg. No. 44,848) along with a statement by Nicole Carlucci and a copy of a transmittal letter dated 3 May, 2004.
- the referenced transmittal letter is explicit that Petitioner transmitted only the oath/declaration (with assignment), but not the entire application (specification: description abstract claims and drawings) to the non-signing inventor Ms. Fernandes.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted.

And a reasonable effort must be made to ascertain a current or last known address.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.²

CONCLUSION

The materials submitted thus far clearly evidence that Petitioner provided a copy of the entire application to the non-signing inventor. Moreover, there is no evidence that Petitioner had made a diligent effort to ascertain and inform the Office of the then-current and valid last known address of Ms. Fernandes.

Petitioner should submit a copy of the transmittal letter and should state the address in the petition over Petitioner's signature and registration number.

² See: MPEP 409.03(b).

Therefore, the instant petition hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: (Effective 1 May, 2003)³
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(703) 872-9306
(Effective 28 September, 2004: (571-273-0025)
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Lobby/Room 1B03
Crystal Plaza Two
220 20th Street S.
Arlington, VA 22202

Telephone inquiries regarding this decision should be directed to the undersigned at 703-305-9199.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.